

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

_____)	
VENTANA MEDICAL SYSTEMS, INC.,)	
)	
Plaintiff,)	
v.)	C.A. No. 05-CV-10614-GAO
)	
VISION BIOSYSTEMS INC.,)	
)	
Defendant.)	
_____)	

**VISION BIOSYSTEMS, INC.'S RESPONSE TO
VENTANA MEDICAL SYSTEMS, INC.'S MOTION TO EXTEND TIME TO RESPOND
TO DEFENDANT'S MOTION FOR SUMMARY JUDGMENT**

Robert J. Muldoon, Jr. (BBO #359480)
Pamela Zorn Adams (BBO #640800)
SHERIN AND LODGEN LLP
101 Federal Street
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Washington, DC 20005
(202) 220-4200

Attorneys for Vision BioSystems, Inc.

Defendant Vision BioSystems, Inc., (“Vision”) respectfully submits this response to Ventana Medical System, Inc.’s (“Ventana’s”) request for a four-week extension of time to respond to Vision’s motion for summary judgment.

As set forth in Vision’s motion for summary judgment, this case is properly disposed of as a matter of law under the legal doctrine of “prosecution history estoppel” based on the patent prosecution history file for Ventana’s asserted ’861 patent, a file that is publicly available from the U.S. Patent & Trademark Office. In order to avoid the heavy expense associated with further pre-trial preparation and trial, Vision filed its motion for summary judgment on June 18th.

Ventana now requests a six-week period to respond to Vision’s motion, the two-weeks ordinarily permitted for response plus a four-week extension. Such an extension is excessive, and Vision opposes it to the extent it further protracts these expensive proceedings, with Vision set to incur significant expense in the case during the months of August through November.

Ventana’s argument that it needs further discovery to respond is baseless. Vision’s summary judgment motion is based almost entirely on the public prosecution history file of Ventana’s patent. The product at issue is the “Bond-OCR” that was the subject of the Complaint in 2005 and was the subject of completed fact discovery in 2005. [D.I. 39]. The corporate deposition on June 26th and 27th that Ventana cites relates to software updates that are irrelevant to the motion for summary judgment. The portion of the “Bond-OCR” at issue—the slide labels—are the same as they have been since 2005. In any event, the deposition is now complete (completed on June 27th). Ventana also cites a deposition that Vision has noticed for August 1st, but that deposition is on the topic of injunctive relief and has absolutely nothing to do with the issue presented in Vision’s motion. [See Ex. 1, Notice of Rule 30(b)(6) Deposition of Ventana Medical Systems, Inc.].

Vision does not dispute Ventana's counsel's other commitments, but the commitments identified do not justify Ventana's request for six weeks to respond. Vision notes that counsel's conflicts minimally, if at all, impact the original filing due date of July 2nd.

Vision filed its motion for summary judgment at the early date that it did in order to avoid the significant expense associated with expert discovery, pre-trial preparation, and trial. Since trial is currently scheduled for November 13, 2007, expert discovery will need to take place largely in August and September to meet that trial date. It is anticipated that the parties will be exchanging at least 7 expert reports and taking 7 corresponding expert depositions, all of which will be unnecessary if the case is resolved on summary judgment, as it should be. If the briefing on Vision's summary judgment motion is delayed by a month as Ventana seeks, the cost-saving benefit that Vision sought from its early filing of its summary judgment motion will be significantly impacted, since the extension will deprive the Court of the opportunity to consider and rule on the motion before the parties will need to embark on expensive expert discovery and further pre-trial proceedings in order to meet the November 13, 2007 trial date.

Respectfully submitted,

Dated: June 27, 2007

/s/ Pamela Zorn Adams

Robert J. Muldoon, Jr. (BBO #359480)

Pamela Zorn Adams (BBO #640800)

SHERIN AND LODGEN LLP

101 Federal Street

Boston, MA 02110

Attorneys for Vision BioSystems, Inc.

EXHIBIT 1

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS**

VENTANA MEDICAL SYSTEMS, INC.,)	
)	
Plaintiff,)	
)	
v.)	Civil Action No. 05-CV-10614-GAO
)	
VISION BIOSYSTEMS INC.,)	
)	
Defendants.)	
)	

**NOTICE OF RULE 30(b)(6) DEPOSITION OF
VENTANA MEDICAL SYSTEMS, INC.**

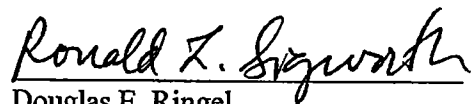
PLEASE TAKE NOTICE THAT pursuant to Fed. R. Civ. P. 30(b)(6) Defendant, Vision BioSystems, Inc. ("Vision") will take the deposition upon oral examination of Plaintiff, Ventana Medical Systems, Inc. ("Ventana") at 9:00 a.m. on August 1, 2007 at the offices of Sherin & Lodgen, LLP, 101 Federal Street, 30th Floor, Boston, Massachusetts 02110, or at another date, time and place as agreed upon by counsel, regarding the subjects identified in the attached "Schedule A."

Pursuant to Rule 30(b)(6) Ventana is requested to designate one or more officers, directors, or managing agents, or other persons to testify on its behalf as to each such subject in the attached "Schedule A," and for each such person designated, advise of all matters on which that person will testify. The deposition will be taken before an officer authorized to administer oaths and will be recorded by stenographic means and videotape, and will continue from day-to-day until completed, or as otherwise agreed upon by counsel.

You are invited to attend and cross-exam.

Dated: June 19, 2007

Respectfully,
Vision BioSystems, Inc.
By its attorneys

A handwritten signature in black ink, reading "Ronald L. Sigworth". The signature is written in a cursive style and is positioned above a horizontal line.

Douglas E. Ringel
John R. Hutchins
Ronald L. Sigworth
KENYON & KENYON LLP
1500 K Street, N.W., Suite 700
Washington, DC 20005
202-220-4200

SCHEDULE A

DEFINITIONS

The definitions included in Plaintiff's First Set of Requests for Production of Documents and Things, and Plaintiff's Second Set of Requests for Production of Documents and Things, are incorporated by reference.

SUBJECTS OF TESTIMONY

1. The amount of all the "time, money and other resources" that Ventana contends it has "invested" "in bringing products relating to the '861 patent to market," including without limitation the factual bases of such contentions, and the nature and identity of documents produced in response to Document Request No. 59. *See* Ventana's Supplemental Response to Interrogatory No. 3 (dated June 8, 2007).

2. The amount of "market share and revenue" Ventana contends it has lost as a result of the alleged infringing activities of Vision, including without limitation the factual bases of such contentions, and the nature and identity of documents produced in response to Document Request No. 60. *See* Ventana's Supplemental Response to Interrogatory No. 3 (dated June 8, 2007).

3. The amount of "market share and revenue" Ventana contends it will lose if Vision's alleged infringing activities are not enjoined, including without limitation the factual bases of such contention, and the nature and identity of documents produced in response to Document Request No. 61. *See* Ventana's Supplemental Response to Interrogatory No. 3 (dated June 8, 2007).

4. The factual bases of Ventana's contention that purchasers of devices allegedly covered by the '861 patent "usually enter into additional high-margin contracts for the sales of

reagents and other consumables, service, etc. for multi-year periods,” including without limitation the nature and identity of all such contracts to which Ventana is or has been a party, the revenues and margins associated with each such contract, and the nature and identity of documents produced in response to Document Request No. 62. *See* Ventana’s Supplemental Response to Interrogatory No. 3 (dated June 8, 2007).

5. The factual bases of Ventana’s contention that “once purchasers have chosen an instrument [allegedly covered by the ’861 patent], they are reluctant to switch,” including without limitation the identity of any specific such purchasers, and the nature and identity of documents produced in response to Document Request No. 63. *See* Ventana’s Supplemental Response to Interrogatory No. 3 (dated June 8, 2007).

6. The factual bases of Ventana’s contention that Vision’s alleged infringing activities if allowed to continue will have a “significant impact on Ventana’s goodwill, market share, and present and future revenues from related products and services,” including without limitation the nature and size of such “impact on Ventana’s goodwill, market share, and present and future revenues from products and services, and the nature and identity of documents produced in response to Document Request No. 64. *See* Ventana’s Supplemental Response to Interrogatory No. 3 (dated June 8, 2007).

7. The factual bases of Ventana’s contention that “many of [Vision’s] customers would have done business with Ventana” had Vision not been in the market, including without limitation the identity of Vision’s customers Ventana contends would have purchased Ventana’s instruments in lieu of instruments from other manufacturers, and the nature and identity of documents produced in response to Document Request No. 65. *See* Ventana’s Supplemental Response to Interrogatory No. 3 (dated June 8, 2007).

8. The factual bases of Ventana's contention that the continuation of Vision's alleged infringing activities would "encourage others to infringe upon Ventana's exclusive patent rights," including without limitation the identity of any persons or entities Ventana contends would infringe and when, and the nature and identity of documents produced in response to Document Request No. 66. *See* Ventana's Supplemental Response to Interrogatory No. 3 (dated June 8, 2007).

9. The nature and identity of periodic internal sales and/or marketing reports that purport to assess, quantify, or evaluate Ventana's market share, revenues, profits, and competitors for devices alleged to be covered by the '861 patent, including without limitation the nature and identity of documents produced in response to Document Request No. 67.

10. The amount of time that it historically has taken Ventana to deliver each of its allegedly patented devices to its customers, measured from the date each such device was ordered by the customer, for all such orders placed from June 2002 to the present, including without limitation the nature and identity of documents produced in response to Document Request No. 68.

11. The factual bases of Ventana's contentions as to why monetary damages would be inadequate to compensate Ventana under the circumstances of this case should the accused devices be found to infringe the '861 patent, including without limitation the nature and identity of documents produced in response to Document Request No. 69. *See* Ventana's Supplemental Response to Interrogatory No. 3 (dated June 8, 2007).

12. The factual bases of Ventana's contention that the entry of a permanent injunction would be in the public's interest under the circumstances of this case should the accused devices be found to infringe the '861 patent, including without limitation the nature and identity of

documents produced in response to Document Request No. 70. *See* Ventana's Supplemental Response to Interrogatory No. 3 (dated June 8, 2007).

13. All patent licensing agreements and amendments thereto, in force at any time from June 2002 to the present, and any other patent license agreements contemplated since 2002, to which Ventana has been a party, including but not limited to the amount of all payments paid or received by Ventana pursuant to such agreement during that time, and nature and identity of documents produced in response to Document Request Nos. 71.

14. The identity of any device on sale in the United States from June 2002 to the present that Ventana contends infringes the '861 patent.

Certificate of Service

I hereby certify that the foregoing **NOTICE OF RULE 30(b)(6) DEPOSITION OF VENTANA MEDICAL SYSTEMS, INC.** was served via facsimile and overnight delivery on June 19, 2007, on the following individuals:

Nicole Stafford, Esq.
Wilson Sonsini Goodrich & Rosati
8911 Capital of Texas Highway North
Westech 360, Suite 3350
Austin, TX 78759-8497
Facsimile: 512-338-5499

Brian L. Michaelis, Esq.
Brown Rudnick Berlack Israels LLP
One Financial Center
Boston, MA 02111
Facsimile: 617-856-8201

DATE: June 19, 2007

A handwritten signature in black ink, appearing to read "Matthew D. Beyer", is written over a horizontal line.

From: Kiltinen, Eric
To: "nstafford@wsgr.com";
CC: "rshulman@wsgr.com"; "rchin@wsgr.com"; Ringel, Douglas;
Sigworth, Ronald;
Subject: Vision v. Ventana: Production Documents & Discovery Requests
Date: Tuesday, June 19, 2007 7:28:51 PM
Attachments: VBS-OCR169789-852.pdf
VBS-OCR 0169479-A - 0169480-D.pdf
2007-06-19 Vision's 3rd Document Requests.pdf
2007-06-19 30(b)(6) Notice to Ventana.pdf
2007-06-19 Kiltinen to Stafford.pdf

Dear Ms. Stafford:

Pursuant to Ron Sigworth's e-mail earlier this evening, attached please find:

- Production documents VBS-OCR 169789-169852.
- Replacement pages VBS-OCR 0169479 A-H and 0169480 A-D.
- Vision's 3rd Set of Document Requests.
- A 30(b)(6) Deposition Notice to Ventana.

Hard copies will follow by FedEx.

Best regards,
Eric

Eric J. Kiltinen | Litigation Case Manager
Kenyon & Kenyon LLP
1500 K Street, NW | Washington, DC 20005-1257
202.220.4326 Phone | 202.220.4201 Fax
ekiltinen@kenyon.com | www.kenyon.com

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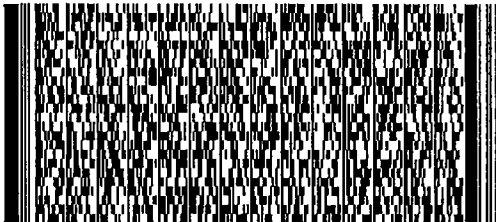
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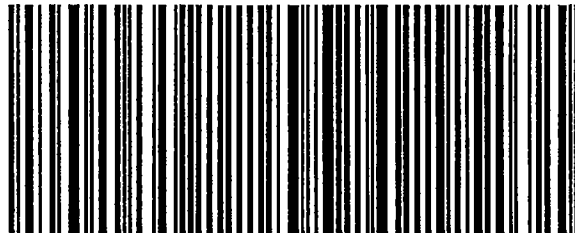
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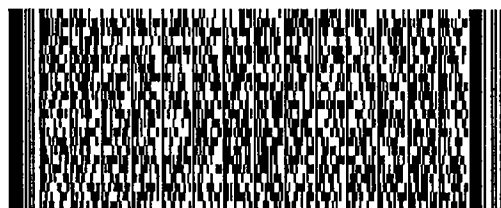
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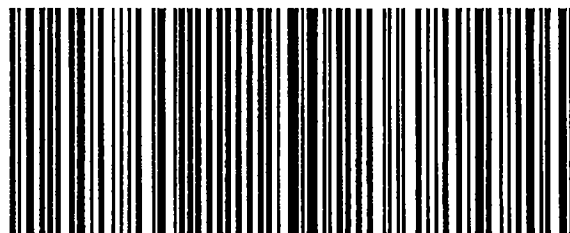
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Pamela Zorn Adams	Sherin & Lodgen LLP	617-646-2222	

Message:

Attached please find:

- Vision's Third Set of Requests for Production of Documents and Things
- Notice of Rule 30(b)(6) Deposition of Ventana Medical Systems, Inc.

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Pamela Zorn Adams	Sherin & Lodgen LLP	617-646-2222	

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